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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,968	12/09/2003	Junichi Asoh	JP920020248US2	3672
53493	7590	05/11/2007		
LENOVO (US) IP Law 1009 Think Place Building One, 4th Floor 4B6 Morrisville, NC 27560			EXAMINER CERVETTI, DAVID GARCIA	
			ART UNIT	PAPER NUMBER
			2136	
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			05/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/730,968

Applicant(s)

ASOH ET AL.

Examiner

David G. Cervetti

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/07/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-12 are pending and have been examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 3/25/2003. It is noted, however, that applicant has not filed a certified copy of the 2003-085359 application as required by 35 U.S.C. 119(b).

Specification

3. The disclosure is objected to because of the following informalities: "USB" (page 2). These terms have not been defined. Appropriate correction is required.

Claim Objections

4. Claim 4 is objected to because of the following informalities: it does not end with a period. Appropriate correction is required.
5. Claim 12 is objected to because of the following informalities: "reasant". Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 8-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8-9 recite the limitation "the method according". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 5-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite “a program for”, a program per se is considered non-statutory subject matter.

10. To expedite a complete examination of the application, the claims rejected under 35 U.S.C. 101 (non-statutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Double Patenting

11. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 10/730,971. Although the conflicting claims are not identical, they are not patentably distinct from each other because **“accepting an operation by a user and issuing an ejection request to the external storage device connected to the computer in accordance with specifications specifying that software control should be performed, including processing to stop access to the device, when ejection is performed; and reading and encrypting a predetermined data file stored in the external storage device and storing the data file in the external storage device, if the ejection request has been issued”** (claim 1, instant application) is analogous to **“acceptance means for accepting an ejection request to**

the external storage device; and encryption means for encrypting a predetermined data file stored in the external storage device if the ejection request has been accepted by the acceptance means” (claim 1, copending application).

12. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 1-15 of copending Application No. **10/730,971** contain every element of claims 1-12 of the instant application and thus anticipate the claims of the instant application. Claims 1-12 of the instant application therefore are not patently distinct from the copending application claims and as such are unpatentable for obvious-type double patenting. A later patent/application claim is not patentably distinct from an earlier claim if the later claim is anticipated by the earlier claim.

14. “A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species with that genus). “ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

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15. "Claim 12 and Claim 13 are generic to the species of invention covered by claim 3 of the patent. Thus, the generic invention is "anticipated" by the species of the patented invention. Cf., *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (holding that an earlier species disclosure in the prior art defeats any generic claim) 4. This court's predecessor has held that, without a terminal disclaimer, the species claims preclude issuance of the generic claim. *In re Van Ornum*, 686 F.2d 937, 944, 214 USPQ 761, 767 (CCPA 1982); *Schneller*, 397 F.2d at 354. Accordingly, absent a terminal disclaimer, claims 12 and 13 were properly rejected under the doctrine of obviousness-type double patenting." (*In re Goodman* (CA FC) 29 USPQ2d 2010 (12/3/1993))

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

17. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas et al. (US Patent 6,529,992, hereinafter Thomas).

Regarding claims 1 and 5, Thomas teaches

- accepting an operation by a user and issuing an ejection request to the external storage device connected to the computer in accordance with specifications specifying that software control should be performed, including processing to stop access to the device, when ejection is performed (**abstract, col. 7**); and
- reading and encrypting a predetermined data file stored in the external storage device and storing the data file in the external storage device, if the ejection request has been issued (**col. 9, lines 12-60**).

Regarding claims 3 and 10, Thomas teaches

- detecting that the external storage device is connected to the computer and checking whether or not an encrypted data file is stored in the external storage device (**abstract, col. 7**); and
- if an encrypted data file is stored in the external storage device, reading the encrypted data file, decrypting the encrypted data file using a passphrase preset and held by predetermined storage means, and storing the decrypted data file in the external storage device (**col. 9, lines 12-60**).

Regarding claims 2, 4, and 8-9, Thomas teaches wherein the method is affixed in a machine readable program (col. 8, lines 17-67, col. 9, lines 12-60).

Regarding claim 6, Thomas teaches causing the computer to function as decryption means for detecting that the external storage device is connected to the computer and decrypting the encrypted data file stored in the external storage device (**col. 7, lines 48-67, col. 8, lines 1-26**).

Regarding claim 7, Thomas teaches causing the computer to function as passphrase managing means for managing a passphrase used for encryption by the encryption means and decryption by the decryption means (**col. 7, lines 48-67, col. 8, lines 1-26**).

Regarding claims 11 and 12, Thomas teaches wherein said program is resident on a computer / an application resident on a server (**col. 8, lines 52-67, col. 9, lines 1-20, 60-67**).

Conclusion


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David G. Cervetti whose telephone number is (571) 272-5861. The examiner can normally be reached on Monday-Friday 7:00 am - 5:00 pm, off on Wednesday.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DGC

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